Docket No. 0756-2659

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT application of
SHUNPEI YAMAZAKI et al.
Serial No. 10/678,139
Filed: October 6, 2003
For: METHOD FOR FABRICATING SEMICONDUCTOR THIN FILM)

Art Unit: 2822
Examiner: GUERRERO

TERMINAL DISCLAIMER

Commissioner for Patents
P.O.Box 1450
Alexandria, VA 22313-1450

Sir:

I, Dr. Shunpei Yamazaki, having a place of business at Semiconductor Energy Laboratory Co., Ltd., 398, Hase, Atsugi-shi, Kanagawa-ken 243-0036 Japan, state that I am authorized to sign on behalf of the assignee of this invention and that the Assignment referred to below has been reviewed and certify that, to the best of my knowledge and belief, the entire right, title and interest in the above-identified application is in the name of Semiconductor Energy Laboratory Co., Ltd. by virtue of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 07701, Frame 0233-0225.

Semiconductor Energy Laboratory Co., Ltd. hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patents No. 5,789,284, and No. RE 38,266E.

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Semiconductor Energy Laboratory Co., Ltd. hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and prior Patents No. 5,789,284, and No. RE 38,266E are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Semiconductor Energy Laboratory Co., Ltd. does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 35 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

10/09/2005
Date

Name: Shunpei Yamazaki
Title: President
Company Name: Semiconductor Energy Laboratory Co., Ltd.

BPAI

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)

*1 BUELL V. BECKESTROM

Patent Interference No. 102,223

January 10, 1992

FINAL HEARING August 13, 1991

Disposable Waste Containment Garment

2005

Patent granted to Kenneth B. Buell on November 3, 1987, Patent No. 4,704,115 filed April 10, 1986, Serial No. 06/851,864. Accorded benefit of Serial No. 06/697,531 filed February 1, 1985.

Application of Bo Beckestrom filed November 2, 1988, Serial No. 07/267,224. Accorded benefit of Serial No. 06/440,947 filed November 12, 1982, now Patent No. 4,490,148 issued December 25, 1984.

Thomas J. Slone, Richard C. Witte, Thomas H. O'Flaherty, Frederick H. Braun, Steven W. Miller, Jerome G. Lee, John F. Sweeney, John C. Vassil and Stanley Schwartz for Buell. Oral argument by John C. Vassil

Robert J. Patch, John P. Milnamow and Allen J. Hoover for Beckestrom. Oral argument by John P. Milnamow

Before Calvert

Vice Chairman

Urynowicz and Staab

Examiners-in-Chief

Staab

Examiner-in-Chief

This interference involves a patent to Buell, U.S. Patent No. 4,704,115, issued November 3, 1987 and assigned to The Procter & Gamble Co., and a reissue application of Beckestrom, Serial No. 267,224, filed November 2, 1988 and assigned to Landstingens Inkopscentral of Solna, Sweden.

The subject matter of the interference relates to a waste containment garment such as a disposable brief for incontinent adults or a diaper. Count 1 is the sole count in issue, and it reads as follows:

Count 1

A waste containment garment having a rear waistband region, a front waistband region, and a crotch region, said garment comprising:

a liquid permeable topsheet;

a liquid impervious backsheet;

an absorbent core intermediate said topsheet and said backsheet;

two inwardly facing, longitudinally extending, impermeable side-edge-leakage guard gutters having proximal and distal edges, said gutters being disposed adjacent the longitudinal side edges of the garment;

means for longitudinally elasticizing said gutters adjacent said distal edges, the garment being sized and configured with respect to the user to enable said distal edges to contact torso areas of the user throughout the lengths of said distal edges and to substantially preclude said distal edges from encircling the thighs of the user;

means for securing the garment on the user so that laterally directed tension is applied to portions of said proximal edges of said gutters which extend between the ends of the garment and the upper thigh elevation of the user; and

means for substantially obviating inversion of said gutters during application and use of the garment.

The claims of the parties which correspond to the count are:

Buell: claims 1-6, 8, 12, 16 and 19.

Beckestrom: claims 26-29.

The following preliminary motions were filed:

(1) Buell's motion under 37 CFR 1.633(a) for judgment as to Beckestrom's claims 26 through 29 on the ground that they are unpatentable under 35 USC 112, first paragraph, as being based upon a specification that does not provide descriptive support for all the limitations of the claims (Paper No. 9).

*2 (2) Buell's motion under 37 CFR 1.633(a) for judgment as to Beckestrom's claims 26 through 29 on the ground that they are unpatentable under 35 USC 251 on the rationales that (a) claims 26 through 29 are broadening reissue claims filed more than two years after the original patent issued and/or (b) Beckestrom has not established that claims 26 through 29 were not included in the original patent because of "error" (Paper No. 10).

(3) Beckestrom's motion under 37 CFR 1.633(f) to be accorded the benefit of the filing date of Swedish Patent Application Serial No. 8204083-3 filed July 1, 1982 (Paper No. 12).

(4) Beckestrom's motion under 37 CFR 1.633(c)(2) to amend claim 26 (Paper No. 13).

(5) Beckestrom's motion under 37 CFR 1.633(f) to be accorded the benefit of the Swedish Patent Application referred to in (3) with respect to claim 26 as amended in (4) (Paper No. 14).

(6) Beckestrom's motion under 37 CFR 1.633(c)(3) to redefine the interference by also designating claims 3 through 6, 8 and 16 of Buell's patent as corresponding to the count (Paper No. 15).

(7) Beckestrom's motion under 37 CFR 1.633(a) for judgement as to Buell's claims corresponding to the count on the ground that they are unpatentable under 35 USC 102 and 103 over prior art, which prior art is not applicable to Beckestrom (Paper No. 17).

(8) Beckestrom's motion under 37 CFR 1.635 for judgement as to Buell's claims corresponding to the count on the ground that they are unpatentable under 35 USC 112, second paragraph (Paper No. 28).

Oppositions were filed in response to all of the above motions except motions (4) and (6).

In a decision mailed June 14, 1990 (Paper No. 31), the Examiner-in-Chief (EIC) granted Buell's motion (1) because Beckestrom's involved application does not have support for the limitation "means for securing the garment on the user so that laterally directed tension is applied to portions of said proximal edges of said gutters which extend between the ends of the garment and the upper thigh elevation of the user" as set forth in claim 26. The EIC also granted Buell's motion (2), reasoning that since Beckestrom does not have support for the above quoted portion of claim 26, it could not have been error not to claim that subject matter. As to Buell's alternative rationale offered in support of motion (2), the EIC concluded that Beckestrom's involved reissue application is entitled to contain claims broader than the claims of the original patent since the involved reissue application is entitled under 35 USC 120 to the benefit of the filing date of an intervening reissue application filed within two years of the original patent. The EIC also denied Beckestrom's motions (3) and (5) because Beckestrom's involved application does not support all the limitations of claim 26. The EIC denied Beckestrom's motion (7) because he concluded that the moving party failed to show that the subject matter of Buell's claims corresponding to the count was anticipated by or would have been obvious in view of the cited references. Finally, the EIC denied Beckestrom's motion (8) that Buell's claims corresponding to the count are unpatentable for failing to particularly point out and distinctly claim the invention which Buell regards as his invention. Pursuant to 37 CFR 1.640 (d)(1), Beckestrom was ordered to show cause why judgement should not be entered against him in accordance with the EIC's decisions.

*3 Beckestrom filed a response to the order to show cause wherein Beckestrom attempted to show good cause why judgment should not be entered in accordance with the EIC's decisions. Beckestrom also filed a request for a testimony period, which was denied, and a request for a final hearing. In addition, Beckestrom filed notice under 37 CFR 1.632 of his intention to argue at final hearing that Buell abandoned, suppressed or concealed an actual reduction to practice. Both parties filed briefs and appeared, through counsel, at final hearing for oral argument.

At the outset, we observe that the issue of abandonment, suppression or concealment, within the meaning of 35 USC 102(g) "cannot arise unless and until a prior actual reduction to practice has been established." Connin v.

Andrews, 223 USPQ 243, 249 (Bd.Pat.Int'f.1984). Also, see Peeler v. Miller, 535 F.2d 647, 190 USPQ 117 (CCPA 1976). Since the parties' preliminary statements have not been opened for inspection and since the EIC has declined to schedule a testimony period, Buell's actual reduction to practice has not been established. Therefore, Beckestrom cannot properly raise the issue of abandonment, suppression or concealment at this time.

The issues to be decided are:

I. Whether Beckestrom has 35 USC 112, first paragraph, support for the his claims corresponding to the count.

II. Whether Beckestrom's involved reissue application filed outside the two year limitation of 35 USC 251 should be accorded, pursuant to 35 USC 120, the benefit of the filing date of an intervening broadening reissue application filed within the two year limitation of § 251 for the purpose of enlarging the scope of the claims of the original patent.

III. Whether Buell's claims corresponding to the count are patentable to Buell under 35 USC 102 and/or 35 USC 103.

IV. Whether Buell's claims corresponding to the count particularly point out and distinctly claim the subject matter sought to be patented as required by the second paragraph of 35 USC 112.

I. Beckestrom's Support for His Claims Corresponding to the Count.

The EIC correctly decided that the disclosure of the involved Beckestrom application does not provide adequate descriptive support for the limitation "means for securing the garment on the user so that laterally directed tension is applied to portions of said proximal edges of said gutters which extend between the ends of the garment and the upper thigh elevation of the user" which appears in claim 26.

Beckestrom contends that support for this limitation is found in column 1, lines 54 through 57, of his original patent (U.S. Patent No. 4,490,148) which reads "(u)sually the diaper according to the invention is held in place with a pair of briefs, which are known per se, but it is also possible to use a girdle, band, tape or the like to hold the diaper in place." It is argued that one skilled in the art would expect tape to function so as to apply lateral tension to the proximal edges of the gutters and/or that the use of tape to hold the diaper in place would inherently provide the recited function of applying laterally directed tension. We cannot accept this argument.

*4 As noted by the EIC in his decision on motions, the prior art patents to Strickland et al (U.S. Patent No. 4,253,461) and Buell (U.S. Patent No. 3,848,594) mentioned on page 17 of Beckestrom's brief are not cited in the original Beckestrom patent and therefore cannot be relied upon for a description that is lacking in the disclosure of the involved Beckestrom application. Furthermore, we are not convinced by Beckestrom's pronouncements regarding what is "conventionally understood" in the art (brief, page 17) that

one skilled in the art would know from reading Beckestrom's disclosure that the tape referred to therein is to function so that lateral tension is applied to the proximal edges of the gutters to hold the diaper in place. Regarding the argument that the use of tape inherently results in the claimed function, we see no reason to conclude that this is necessarily so, especially since Beckestrom's disclosure offers no hint of such a function and since Beckestrom's specification groups tape with other holding means, such as briefs, a girdle and a band, which are seen as providing compression to the edges of the gutters rather than lateral tension. Accordingly, we are not persuaded that the EIC was in error in determining that Beckestrom's application does not have 35 USC 112 support for the subject matter of claims 26 through 29.

II. Beckestrom's Right to Present Claims Broader than Those Claims Issued in His Original Patent.

Beckestrom's application S.N. 440,947 filed November 12, 1982 for an invention entitled PROTECTOR AGAINST INCONTINENCE OR DIAPER issued as U.S. Patent No. 4,490,148 on December 25, 1984. The '148 patent was subjected to a reexamination procedure which resulted in the issuance of a reexamination certificate narrowing the scope of the claims of the original patent. On December 29, 1986, two years and four days after issuance of the original patent, Beckestrom filed broadening reissue application S.N. 946,531 seeking to enlarge the scope of the reexamined claims of the '148 patent. Because December 25, 26, 27 and 28, 1986 were non-business days in the Patent and Trademark Office, the '531 application was considered to be filed within the two year period under 35 USC 251 for a reissue application enlarging the scope of the claims of the original patent. On November 2, 1988, while the '531 application was still pending [FN1] and nearly four years after the '148 patent issued, Beckestrom filed the involved reissue application S.N. 267,224 as a division [FN2] of the '531 application, together with a preliminary amendment adding claims 26 through 29. Claims 26 through 29 of the '224 application, which correspond to the count of the present interference, are acknowledged to be broader than both the original and reexamined claims of the '148 patent.

Beckestrom argues that since the PTO recognized his earlier '531 reissue application as being filed within the two year period prescribed by 35 USC 251, his divisional reissue application should have the same effect as though such application had been filed on the date when the earlier broadening reissue application was filed. Beckestrom cites In re Bauman, 683 F.2d 405, 214 USPQ 585 (CCPA 1982) for the proposition that reissue applications continuing from reissue applications are within the scope of § 120 and In re Hogan, 559 F.2d 595, 604, 194 USPQ 527, 536 (CCPA 1977) for the proposition that section 120 is applicable to all bases of rejection. Beckestrom also cites In re Doll, 419 F.2d 925, 164 USPQ 218 (CCPA 1970) for the proposition that broadening claims may be presented in a reissue application filed within two years after a patent grant even though such claims were not presented until more than two years after the patent grant and were broader than the original patent claims and the broadened reissue claims originally submitted.

*5 Buell contends that the EIC's decision according Beckestrom's '224 divisional reissue application the benefit of the '531 reissue application's

filing date pursuant to 35 USC 120 is based on a misinterpretation of Bauman and Hogan that circumvents the express two year limitation on broadening reissue applications of 35 USC 251. In Buell's opinion, Bauman and Hogan are distinguishable because the two year limitation of section 251 was not implicated in either of these cases. As to Doll, Buell notes that the further broadening claims in that case were added by amendment in a timely filed application for a broadening reissue rather than in a separate application filed outside the two year limitation. Buell argues that an extension of time of the two year limitation of § 251 is against public policy and cites In re Fotland, 779 F.2d 31, 228 USPQ 193 (Fed.Cir.1985) in support of this argument. Buell cites Stohr v. Brenner, Comr.Pats., 157 USPQ 675 (D.D.C.1968), aff'd, 417 F.2d 1149, 162 USPQ 73 (D.C.Cir.1969), for the proposition that continuing applications cannot be used as a vehicle for obtaining a potentially unrestricted extension of time in which to file a broadening reissue application. From Buell's perspective, Stohr is the only case in which the policies behind both § 120 and the two year limitation of § 251 were implicated.

There is no dispute that the involved reissue application satisfies the basic statutory requirements of section 120 of copendency, continuity of inventorship, and reference to the earlier application. For purposes of this discussion, we shall assume that the invention sought to be patented was "disclosed in the manner provided by the first paragraph of section 112" as also required by section 120. In Bauman, the court, in holding that a regular, nonreissue application can be entitled to the benefit of the filing date of a reissue application under section 120, noted at 214 USPQ 587 that "[i]ndeed, the PTO acknowledges that reissue applications continuing from reissue applications are within the scope of section 120." Moreover, in Hogan, the court said at 194 USPQ 536 that "[n]othing in § 120 limits its application to any specific grounds of rejection" and that "symmetry of the law, and evenness of its application, require that § 120 be held applicable to all bases for rejection, and its words 'same effect' be given their full meaning and intent." The court was there referring to the language of section 120 which provides "an application ... shall have the same effect, as to such invention, as though filed on the date of the prior application." In light of Doll, Bauman and Hogan, we believe that the EIC was correct in concluding that Beckestrom is not precluded by the two year limitation of 35 USC 251 from presenting claims in his involved reissue application to the invention disclosed in his original patent that are broader than the claims of the patent.

*6 As to the Stohr case cited by Buell for the proposition that continuing applications cannot be used to circumvent the two year limitation of section 120, the facts in Stohr are vague and other factors, possibly relevant, are present. No analysis pertinent to the issue presented here is provided. Accordingly, we do not consider Stohr to be of assistance in deciding the issue before us.

III. The Patentability of Buell's Claims Corresponding to the Count Under 35 USC 102 and/or 35 USC 103.

We agree with Beckestrom that the EIC erred in determining that Buell's claims corresponding to the count were patentable over the prior art cited by

Beckestrom. Specifically, it is our view that Buell's claims corresponding to the count are unpatentable under 35 USC 103 over Beckestrom's Japanese Patent (Unexamined Publication) No. 59-25741 published February 9, 1984 or Beckestrom's European Patent No. 98,512 A2 published January 18, 1984, in view of U.S. Patent No. 4,253,461 to Strickland or U.S. Patent No. 4,500,316 to Damico.

The diapers of each of the Beckestrom patents include a liquid permeable topsheet 29, a liquid impervious backsheet 16, and an absorbent core 10 intermediate the topsheet and the backsheet. The folded end edge strips 17, 18 comprise leakage guard gutters and the elastic strips 21, 22 comprise means for longitudinally elasticizing the gutters adjacent the distal edges thereof. Since the strips of Beckestrom extend the entire length of the garment and have a width approximately one-fourth to one-third the width of the diaper (European specification, page 5; Japanese translation, pages 7-8), we consider Beckestrom's garment to be sized and configured to enable the distal edges of the strips to contact torso areas of the user throughout the lengths of the distal edges and not encircle the thighs of the user. In this regard, the statement in Beckestrom's European and Japanese patents to the effect that the free edges of the strips fit into folds of the thigh in the crotch area of the user neither suggests nor requires encirclement of the thigh by the free edges, as argued by Buell. The connection of the ends 25, 26, 27 and 28 of the edge strips to the topsheet 29 prevents, at least to some degree, inversion of the strips during application and use and therefore constitutes means for substantially obviating inversion, as claimed. Beckestrom states that the diaper is secured to the user by panties or a hip belt, etc. (European specification, page 3) or a brief, girdle, band, tape or the like (Japanese translation, page 5). Accordingly, the Beckestrom patents disclose the invention of claim 26 except for means for securing so that laterally directed tension is applied to portions of the proximal edges of the gutters which extend between the ends of the garment and the upper thigh elevation of the user.

*7 Strickland discloses securement means in the form of tapes 15, well-known in the art, which provide laterally directed tension to the waist area portion of the disposable incontinent brief. See column 6, lines 20 through 26. Similarly, Damico states that tapes 18a, b and c, similar to those in use on conventional disposable diapers, establish laterally directed lines of resistance which oppose lateral waist band contracting forces in the disclosed incontinent garment. See column 6, lines 3 through 20. It would have been obvious to one of ordinary skill in the art, seeking to improve upon the incontinent garment or diaper of Beckestrom, to provide tape type securement means in the waist area of Beckestrom's garment in order to take advantage of the known convenience such tapes provide. In applying such tape fasteners, the ordinarily skilled artisan would attach them to the outer edges of the garment in the waist area of the user, i.e., to the proximal edges of Beckestrom's strips or gutters 17, 18 at the upper thigh elevation of the user. As is evident from the above noted portions of Strickland and Damico, the provision of tapes in Beckestrom according to the teachings of the secondary references would establish laterally directed lines of resistance in the waist area of the garment.

In arriving at our conclusion, we have fully considered Buell's argument that there is no teaching in the applied references of applying laterally directed

tension to the proximal edges of the gutters to keep the gutters open. However, this argument fails at the outset because it is predicated upon a limitation that is not present in Buell's claims corresponding to the count. See In re Self, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982).

IV. The Patentability of Buell's Claims Corresponding to the Count Under 35 USC 112, Second Paragraph.

In opposing Beckestrom's motion (7) that Buell's claims corresponding to the count are unpatentable under 35 USC 103, Buell argued that there is no teaching or suggestion in the prior art of applying lateral tension to keep the leakage-guard gutters open and fit to the wearer during use as required by the Buell invention. In response, Beckestrom filed motion (8) alleging that since Buell now considers his invention to include applying lateral tension to keep the gutter open and since the claims corresponding to the count do not require this feature, Buell's claims do not particularly point out and distinctly claim the invention which Buell regards as his invention, as required by the second paragraph of 35 USC 112. Buell maintains that when construed in light of the specification, one of ordinary skill in the art would understand the laterally directed tension applied to the proximal edges of the gutters causes the gutters to remain open during use.

It is axiomatic that during the prosecution of a patent application, claims are to be given their broadcast reasonable interpretation. See In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed.Cir.1989). We agree with Beckestrom that Buell's claims do not require the laterally directed tension to be applied such that the gutters remain open during use. However, this fact by itself is not offensive to the second paragraph of 35 USC 112. While the claim language under consideration may be broad, breadth is not indefiniteness. See In re Gardner, 427 F.2d 786, 166 USPQ 138 (CCPA 1970). Instead, the second paragraph of section 112 simply requires the claims to set forth and circumscribe a particular area with a reasonable degree of precision and particularity. See In re Moore, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971). This Buell has done. Accordingly, we conclude that Buell's claims corresponding to the count are not unpatentable under 35 USC 112, second paragraph.

*8 In view of our findings above that Beckestrom's claims corresponding to the count do not have proper descriptive support under 35 USC 112, first paragraph, and that Buell's claims corresponding to the count are not patentable to Buell under 35 USC 103, judgment against both parties is entered hereinbelow.

Judgment

Judgment as to the subject matter of the count in issue is hereby awarded against Kenneth B. Buell, the junior party. The junior party Buell is not entitled to his patent with claims 1 through 6, 8, 12, 16 and 19 corresponding to the count.

Judgment as to the subject matter of the count in issue is hereby awarded

against Bo Beckestrom, the senior party. The senior party Beckestrom is not entitled to a patent with his claims 26 through 29 corresponding to the count.

BOARD OF PATENT APPEALS AND INTERFERENCES

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Vice Chairman

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Examiner-in-Chief

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Examiner-in-Chief

FN1. On November 7, 1989, the '531 application issued as patent No. Re 33,106. Apparently, neither the '531 application nor the involved '224 application was referred to the Commissioner pursuant to 37 CFR 1.177. According to said regulation, the '531 application should have been withheld from issue until the controversy surrounding the involved '224 reissue application was resolved in the absence of an order from the Commissioner. The involved reissue application will be forwarded to the Commissioner in due course.

FN2. The '224 reissue application would appear to be directed to the same invention as the '531 reissue application. However, in order to avoid confusion as to the application intended, we will continue to refer to the '224 reissue application as a division rather than a continuation of the '531 application.